



PTO/SB/33 (07-05)

United States Patent &amp; Trademark Office; U.S. DEPARTMENT OF COMMERCE

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>	Docket Number (Optional) 58268.00015
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed Name _____	Application Number:  09/885,929
	Filed: June 22, 2001
	First Named Inventor:  Mohan KALKUNTE, et al.
	Art Unit: 2665  Examiner: Davis, Cynthia L.

**Mail Stop AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under  
37 CFR 3.73(b) is enclosed
- ☒ Attorney or agent of record.  
Registration No. 51,091

- ☐ Attorney or agent acting under 37 CFR 1.34.  
Reg. No. is acting under 37 CFR 1.34 \_\_\_\_\_

  
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March 3, 2006  
\_\_\_\_\_  
Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

- ☐ \*Total of \_\_\_\_\_ forms are submitted.



**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Mohan KALKUNTE, et al.

Art Unit: 2665

Application No.: 09/885,929

Examiner: Cynthia L. DAVIS

Filed: June 22, 2001

Attorney Dkt. No.: 58268.00015

For: SWITCH HAVING EXTERNAL ADDRESS RESOLUTION INTERFACE

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

March 3, 2006

This is a Pre-Appeal Brief Request for Review from the final rejection set forth in an Office Action dated September 12, 2005 ("Office Action"), finally rejecting claims 1-12. Applicants submit that cited references fail to disclose or suggest all of the limitations of any of the pending claims and that these failures constitute clear error with regard to this final rejection.

**The cited references fail to disclose or suggest all of the limitations of any of the pending claims.**

The claim rejections are set forth in page 2 of the Office Action. The Office Action rejected claims 1-4 and 6-11 under 35 U.S.C. 103(a) as being obvious over US Patent No. 6,570,855 to Kung et al (Kung), in view of US Patent No. 6,310,874 to Miller et al. (Miller). The Office Action took the position that Kung disclosed all of the features of these claims, with the exception of an external address resolution switch. The Office Action asserted that Miller disclosed this feature.

Applicants submit that the cited references, taken individually or in combination, fail to disclose or suggest all of the features recited in any of the above claims.

Claim 1, from which claims 2-5, 8, 11, and 12 depend, recites a network switch. The network switch includes a plurality of input ports that receive data packets, and an external address resolution interface connected to at least one of the plurality of input ports, the external address resolution interface externally transmitting the data packets for processing, and receiving the data packets after processing, wherein the external address resolution interface is coupled to an external address resolution switch. The network switch further includes a memory management unit connected to the external interface; and a plurality of output ports connected to the memory management unit.

Claim 6, from which claim 9 depends, recites a method of processing a data packet in a network switch. The method includes receiving a data packet in an input port, transmitting the data packet from the input port over an interface to an external switch for address resolution, and processing the packet in the external switch. The method further includes transmitting the packet from the external switch to the interface, receiving the data packet in the interface from the external switch. The method further includes transmitting the data packet from the interface to a memory management unit, and transmitting the data packet from said memory management unit to an output.

Claim 7, from which claim 10 depends, recites a network switch. The network switch includes an input port receiving means for receiving a data packet in an input port, and an input port transmitting means for transmitting the data packet from the input port over an interface to an external switch for address resolution. The network switch further includes a processing means for

processing the packet in the external switch, and an external switch transmitting means for transmitting the packet from the external switch to the interface. The network switch further includes an interface receiving means for receiving the data packet in the interface from the external switch, an interface transmitting means for transmitting the data packet from the interface to a memory management unit, and a memory unit transmitting means for transmitting the data packet from the memory management unit to an output port.

Kung is directed to an automatic call manager traffic gate feature. Kung discloses a router 200 (which can be a gigabit switch, Figure 2). The router includes a connection to a DNS server 214, which can be combined with other servers such as a call manager server 218 and a trivial file transfer protocol server into a single server. See column 7 lines 1-7. The Office Action admits that Kung fails to disclose the feature of an external address resolution module but alleges that Miller discloses this feature.

Miller is directed to a frame throttle. Figure 1 of Miller illustrates a switch that includes several input/output application specific integrated circuits 12, 14, 16, and 18 (I/O ASICS) that are interconnected via an address resolution processor 20. See Miller at column 2 lines 15-21.

Applicants respectfully submit that the cited references fail to disclose or suggest all of the features recited in the pending claims. Specifically, the cited references fail to disclose at least the feature of a coupled external address resolution switch, as recited in claim 1 and similarly recited in claims 6 and 7 because Miller fails to make up for the admitted deficiencies of Kung, and the combination is therefore an improper basis upon which to reject claim 1. Thus, the Office Action is in clear error in rejecting the pending claims because a prima facie case of obviousness has not been established.

To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

As discussed above, the mere fact that Kung discloses a DNS for address resolution and Miller merely mentions a switch with an address resolution processor, does not support the Office Action's assertion that Miller cures the admitted deficiencies of Kung. Miller merely discloses implementing the frame throttle "in a switch having an address resolution processor for resolving multicast address information" (see column 2 lines 9-11 of Miller). Further, Miller fails to disclose or suggest that this switch is an external switch for address resolution, as clearly recited in the pending claims.

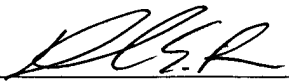
Still further, the cited combination would render the prior art invention unsatisfactory for its intended purpose because the address resolution contemplated by the cited references are performed at different levels. The domain name server (DNS) is a higher protocol than the address resolution contemplated in Miller. For example, the address resolution contemplated in Miller is in regards to determining through which ports of the switch to transmit data packets.

Therefore, Applicants respectfully submit that the cited references fail to disclose or suggest all of the features of the pending claims. Specifically the cited references fail to disclose or suggest at least the feature of an external address resolution switch as recited in the pending claims.

## Conclusion

For all of the above noted reasons, it is respectfully requested that the outstanding rejections be withdrawn, because the cited references do not teach or suggest all of the elements of any of the presently pending claims. Hence, the lack of a *prima facie* case of obviousness constitutes clear error as a basis for rejecting the presently pending claims. Therefore, it is respectfully requested that all of the pending claims be allowed, and that this application be passed to issue.

Respectfully submitted,

  
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Enclosures: Form PTO/SB/33  
Notice of Appeal